



Atty. Dkt. No. 040302-0378

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Tomohiro KONDO et al.

Title: SURFACE FINISHING APPARATUS AND RELATED METHOD

Appl. No.: 10/772,429

Filing Date: 2/6/2004

Examiner: Hadi SHAKERI

Art Unit: 3723

Confirmation 6123
Number:

REPLY BRIEF ON APPEAL

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Sir:

Under the provisions of 37 CFR § 41.41, Appellants submit this Reply Brief on Appeal to respond to the Examiner's Answer mailed on September 29, 2008.

I. Appellants' Repeated Requests for Clarification of the Examiner's Positions On the Prior Art Have Been Consistently Ignored

In view of Appellants' belief that the prior art contains deficiencies with respect to the elements of the claims, on two occasions (Appeal Brief, pages 15-16; Response of March 05, 2008, pages 11-12) Appellants provided a claim chart, and simply requested that the Examiner fill out the claim chart, in order to identify the apparent disconnect between Appellants' understanding of the present invention and the Examiners' understanding of the present invention. To date, the Examiner has never taken the simple step of filling out this chart, or otherwise indicating where each and every element may be found in the cited references. Instead, on page 7, the Examiner broadly asserts that the "claim chart . . . had been filled in by Judge in view of JP '090." Appellants submit that this clearly demonstrates the weakness of the proffered rejections.

II. The Examiner Asserts the Obviousness of the Present Invention Using Only Conclusory Statements

The Examiner asserts that it would have been obvious to combine Judge (U.S. Patent No. 4,682,444) and JP '090 (Japanese Publication No. 10-217090) "to prevent local excessive shaving." (Examiner's Answer, page 4.) That is the extent of his rationale for combining Judge and JP '090. The Supreme Court's decision in *KSR* makes clear that

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness".

(*KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396, (2007), citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006).) It is respectfully submitted that the rationale for combining the cited references is merely a conclusory statement, which is forbidden by *KSR*.

Moreover, this alleged motivation to combine the cited references is circular, and simply relies on the fact that JP '090 details a general advantage of its teachings, as is the case with almost every patent application. There is no evidence or rationale indicating that Judge suffers from any operational deficiency, let alone the one alleged to be remedied by JP '090.

III. The Examiner Rarely Addresses Appellants' Arguments, and Cites Case Law Without any Analysis

The Examiner rarely addresses Appellants' arguments, other than making the general assertion that the arguments are not persuasive, and applies case law in a manner that is broadly stated and without targeted application to the facts at hand, without analogizing facts of a cited case to those of the present application.

IV. The Teachings of Judge are Mischaracterized

The Examiner's assertion that Judge is "capable of being used" according to the claimed invention is a mischaracterization of the teachings of Judge. (Examiner's Answer, pages 4-5, paragraph spanning.) Instead, Judge must be modified to arrive at the present invention, hence the combination of Judge with JP '090. Further, the mere fact that a prior art device is capable of being modified to arrive at the present invention does not render the present invention obvious. The results of that modification must, among other things, have been predictable to one of ordinary skill in the art. (MPEP §2143.01(III), citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).) Here, no evidence or rationale has been proffered by the Examiner to indicate that the alleged modification to the prior art would have provided predictable results.

Moreover, the assertion that Judge is "capable of being used" according to the claimed invention is basically an assertion that the claims are obvious simply because the modification would have been within the capability of one of ordinary skill in the art. This is not the standard for obviousness, and such grounds for formulating an obviousness rejection are forbidden by *KSR*. (MPEP §2143.01(IV), citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).)

V. The Requirements for Rejecting a Claim Based on Optimization Have Been Ignored

The Examiner relies on "optimizing the operation [of Judge] based on intended results" to support his rejections. (Examiner's Answer, page 5.) Yet, the Examiner addresses none of the requirements detailed in the case law and MPEP for rendering an invention

obvious based on “optimization.” Appellants presented these requirements in their Appeal Brief (see pages 24-25), and they are clearly recited in the MPEP, yet the Examiner completely disregarded the requirements. The requirements for rejecting a claim based on optimization have not been met.

VI. Unfounded Assertions in the Examiner’s Answer Which are not Definitive with Respect to Obviousness

On page 5 of the Office Action, the Examiner states that

[i]f a person of ordinary skill using the combined prior art apparatus were to obtain a uniform polishing surface on a workpiece that has a concave mid-portion, the artisan would have been able in view of JP ’090 to set the oscillation and/or set the positions of the shoes such that excessive shaving is avoided.

(Emphasis added.) This again merely points to an alleged ability of the ordinary artisan to modify Judge - not the inventiveness of that modification. Indeed, assuming *arguendo* that the just-quoted assertions are accurate, the Examiner never explains how this renders the claimed invention obvious. At most, the Examiner asserts that the claimed invention was within the skill of the art, which, by itself, does not result in the obviousness of a patent claim.

VII. JP ’090 Teaches Away from Combination with Judge

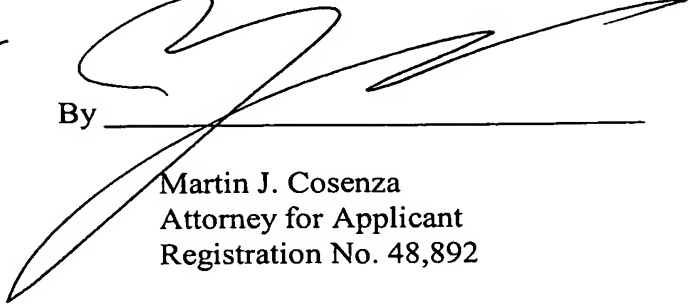
As is detailed in the Appeal Brief on pages 26-27, but addressed nowhere in the Examiner’s Answer, JP ’090 is entirely directed towards “improving straightness,” and thus teaches away from incorporating the teachings of JP ’090 into a device for producing a curved surface such as Judge. Webster’s Dictionary defines “curved” as “to have or take a turn, change, or *deviation from a straight line* . . . without sharp breaks or angularity.” Based on Webster’s definition of the word “curved,” it is clear that the device of JP ’090 is for producing a result that is the exact opposite of the result obtained by the device of Judge; the former purposely producing a straight surface, the latter purposely producing a curved surface. JP ’090 teaches away from combination with Judge.

VII. Conclusion

Appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejections of the pending claims.

Respectfully submitted,

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If Appellant has not accounted for any fees required by this Amendment, the Commissioner is hereby authorized to charge to Deposit Account No. 19-0741. If Applicants have not accounted for a required extension of time under 37 C.F.R. § 1.136, that extension is requested and the corresponding fee should be charged to our Deposit Account.